

REMARKS

Applicants have studied the Office Action dated September 16, 2003. Claims 1-36 are pending. Reconsideration and further examination of the pending claims in view of the following remarks is respectfully requested. In the Office Action, the Examiner:

Rejected claims 1-8, 12-19, 23-30 under 35 U.S.C. § 102(e) as being anticipated by *Cannon et al* (Cannon) (U. S. Patent No. 5,974,447).

Rejected claims 9-11, 20-22 and 31-33 under 35 U.S.C. § 103(a) as being unpatentable over *Cannon et al* (Cannon) (U. S. Patent No. 5,974,447).

The Applicants respectfully traverse the Examiner's rejection of the pending claims for the reasons stated below. Applicants respectfully submit that the pending claims are in condition for allowance and that the Examiner's rejections should be withdrawn.

Overview of the Present Invention

The presently claimed invention is directed to a method and system for an information handling system that receives information relating to a subscriber personal profile comprising subscriber content preferences and fetches content from a content database according to the subscriber content preferences, wherein the fetches content is organized into at least one channel. The content from the at least one channel is mixed into a stream of data according to the subscriber personal profile comprising subscriber content preferences. The stream of data is transmitted for receipt by a remote subscriber unit via a wireless medium for audio rendering to a user. Various aspects of the present invention also include mixing and/or combining multiple channels for transmission, allowing a channel to interrupt a default channel, play different channels through different speakers of a receiver, and provide a text-to-audio converter in the remote subscriber for converting textual content to audio content that can be

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heard by the user.

Amendments to the Claims

Applicants have amended the claims to correct a typographical error and to more clearly define the features of the claimed invention. Claim 10 has been amended to correct a typographical error of "Transmittted" to "Transmitted."

Claim 34 has been amended to more clearly identify that a text-to-audio converter is part of a remote subscriber unit. Support for this amendment is found in the specification at, for example, page 5, lines 10-13.

Claim 1, from which claim 34 depends, has also been amended to remove a text-to-audio converter element in order to provide a correct antecedent basis.

Rejection under 35 U.S.C. §102(e) as being anticipated by Cannon

As noted above, the Examiner rejected claims 1-8, 12-19 and 23-30 under 35 U.S.C. § 102(e) as being anticipated by Cannon. The Examiner cites 35 U.S.C. § 102(e) and a proper rejection requires that a single reference teach (i.e., identically describe) each and every element of the rejected claims as being anticipated by Cannon.¹

Cannon Does Not Teach the Claimed Elements of the Present Invention

To begin, Cannon is directed to coupling a selective call receiver to widely distributed information sources. Cannon teaches selecting and formatting information from different sources based upon various considerations, including a user profile (Cannon, Column 2, lines 51-67, Column 3, lines 1-12). Cannon further teaches

¹ See MPEP §2131 "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." (Emphasis Added) *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim."

specifying criteria by which to search for information that is sent to the user. (Cannon, Column 3, lines 13-14).

Applicants note that there is a possible point of confusion between channels as discussed in the Cannon reference and the channels of the applicants' claimed invention. Cannon discusses an ability of the user to control message routing over various communications channels to the same or different devices. Cannon, Column 3, lines 30-40. Cannon discusses delivering "information back to the user, using the same channels that the user used to get to the agent." Cannon, Column 3, lines 34-35. Cannon then goes on to discuss an alternative of delivering information elsewhere, such as allowing the user to specify a facsimile number or e-mail address. It is clear that the term "channel" as used by Cannon refers to a communications channel, such as a radio frequency channel or wire-line data communications channel. In contrast to Cannon, the claimed elements of the Applicants' invention use the term "channel" as an entity into which "content is organized" See, Claim 1.

Separately, the Examiner's Response to Arguments apparently states that "Channel" of the presently claimed invention is similar to the "Source" that is taught in Cannon. Applicants respectfully point out that the term "Source" as used in Cannon describes a source of information. For example, Cannon describes "various sources, such as different web pages[.]" Cannon, Column 2, line 59. In contrast to Cannon, the present invention describes "channels" as "streams of data," as in the case of "when a new stream of data is sent from the server 14 (either when the system first starts or when the channel is changed)." Specification, page 9, lines 1-2 (Emphasis added).

With regards to a limitation recited in Claim 1 of "a content database for storing content, wherein the content is organized into at least one channel[.]" Cannon does not teach a content database that organizes content into at least one channel. The examiner cites a portion of Cannon that states "a server for retrieving user selected information from a widely distributed information source." Applicants respectfully assert that "retrieving information from a widely distributed information source," as is taught by Cannon, is not the same as a "content database for storing content, wherein the

content is organized into at least one channel[.]" as is claimed by the present invention. The "widely distributed information source" of Cannon includes a "different web pages. Cannon, column 2, lines 58-60. In contrast, the present invention stores, in a database, content that is organized into channels. See Specification, Figure 3, page 5, line 23 through page 6, line 26.

With regards to the limitation of Claims 1, 12 and 23, the present invention organizes information into at least one channel. In contrast to the claimed elements of the present invention, Cannon only teaches an "ability to dynamic parse and customize information that would be delivered to a user." Cannon, column 2, lines 52-53 (Emphasis added). This customization is based on various information, such as channel capacity and cost. Cannon, column 2, lines 53-57.

In contrast to the claimed invention, Cannon does not teach, anticipate or suggest the claimed aspects of the present invention, which include organizing content into at least one channel, and having subscriber content preferences that comprise preferences for at least one preferred channel within the channels into which the content is organized, as is recited for the presently claimed invention. The channels used by an exemplary embodiment of the present invention includes stock channels and music channels (Specification, page 6, lines 2-3 and 20-22). This advantageously provides the user with "pre-selected" information categories to which further subscriber content preferences can be applied.

With regards to amended claim 34, the applicant's invention claims a remote subscriber unit comprising a text-to-audio converter for converting textual content to audio content. The invention claimed in claim 34 has the text-to-audio converter in the remote subscriber unit. In contrast to the claimed invention, Cannon teaches a text-to-audio converter that is part of the server, so that a voice-audio over-the-air protocol can be used. The claimed invention's use of a text-to-audio converter in the remote subscriber unit advantageously allows text data to be transmitted to the remote subscriber unit. Transmission of text to the remote subscriber unit in this aspect of the present invention results in the transmission of less data that is required to transmit the voice data directly, as is taught by the Cannon reference. Applicants therefore

respectfully assert that amended claim 34 distinguishes over the Cannon reference and that the rejection of amended claim 34 under 35 U.S.C. 102(e) is improper and should be withdrawn.

For the foregoing reasons, independent claims 1, 12 and 23 distinguish over the cited references. Claims 2-8 and 34-35, 13-19, 36 and 24-30 depend from claims 1, 12 and 23, respectively, and include all of the limitations thereof. Therefore claims 2-8 and 34-35, 13-19, 36 and 24-30 also distinguish over cited references for at least the above reasons as well. Therefore, the Applicants respectfully submit that the rejection of these claims under 35 U.S.C. §102(e) should be withdrawn.

Rejection under 35 U.S.C. §103(a) as Unpatentable over Cannon

As noted above, the Examiner rejected claims 9-11, 20-22, 31-33, and 35-36 under 35 U.S.C. § 103(a) as being unpatentable over Cannon. The Examiner recites 35 U.S.C. §103. The Statute expressly requires that obviousness or non-obviousness be determined for the claimed subject matter "as a whole," and the key to proper determination of the differences between the prior art and the present invention is giving full recognition to the invention "as a whole."

As noted by the Examiner, Cannon does teach that time variable information is able to be formatted in different ways based upon such things as channel capacity or cost. The Cannon system is implemented in a selective call transceiver, such as a paging environment, wherein peak transmission periods, such as rush hours, place a premium on transmission of information without delay. Some paging systems might increase transmission charges to discourage transmissions during these peak periods, thereby creating a user preference to restrict timing due to costs. Applicants submit that such reformatting does not teach or make obvious the claimed aspects of the present invention, which include user configurable mixing or combining of information or content as is claimed for aspects of the present invention by dependent claims 9, 20 and 31. There is just no teaching or suggestion in the Cannon reference of

simultaneous delivery of information as is claimed by the present invention. Applicants respectfully reassert that the Examiner's statement of a motivation to include the limitation found only in the Applicants' invention is not sufficient establish *prima facie* obviousness the combination of elements claimed by the Applicants. As has been repeatedly held:

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). I

MPEP §2143.03 (Emphasis added)

Furthermore, when there is no suggestion or teaching in the prior art user configurable mixing or combining of information or content, the suggestion can not come from the Applicant's own specification. As the Federal Circuit has repeatedly warned against using the Applicant's disclosure as a blueprint to reconstruct the claimed invention out of isolated teachings of the prior art. See MPEP §2143 and *Grain Processing Corp. v. American Maize-Products*, 840 F.2d 902, 907, 5 USPQ2d 1788 1792 (Fed. Cir. 1988) and *In re Fitch*, 972 F.2d 160, 12 USPQ2d 1780, 1783-84 (Fed. Cri. 1992).

Claims 10, 21 and 32 claim an aspect of the present invention whereby mixing of content is performed by interrupting a default channel with specified information. Claims 11, 22 and 33 claim an aspect of the present invention whereby mixing of content is performed by simultaneously playing multiple channels of information. This is a valuable advantage of the presently claimed invention that is not found, taught, or suggested by any of the cited prior art. See the originally filed specification on page 6, particularly on lines 16-19 and 23-26, for a more detailed discussion of the advantages of these presently claimed aspects. These aspects of the present invention are not

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taught, suggested or made obvious by the cited references, since mixing of information that is organized in channels for delivery and presentation to a user is not discussed in the cited references. As noted above, "all the claim limitations must be taught or suggested by the prior art" and "all words in a claim must be considered in judging the patentability of that claim against the prior art." MPEP §2143.03 (Emphasis added)

Claims 35 and 36 claim "wherein a subset of the mixed/combined information from multiple channels is sent to one of a plurality of speakers." The Examiner cites a portion of Cannon that only discusses converting text information into voice signals at the server and transmitting this voice information to a subscriber unit for audio playback. The cited portion of Cannon reads:

Thus, if a particular TENOR™ subscriber unit only had voice capability and the source of information was only available in text, the agent at the server would include a text to speech converter or translator allowing for audible "viewing" of the text.

Cannon, Column 4, lines 25-30. (Emphasis added).

In contrast to the claimed invention, the Applicants respectfully submit that Cannon does not mention a plurality of speakers. As discussed above, Cannon also does not mention a mixed or combined voice signal. Applicants respectfully assert that it is improper to assert an obviousness rejection when the Applicants' disclosure provides the only teaching of the claimed elements of the rejected claims. As noted above, "all the claim limitations must be taught or suggested by the prior art" and "all words in a claim must be considered in judging the patentability of that claim against the prior art." MPEP §2143.03 (Emphasis added)

For the foregoing reasons, dependent claims 9-11, 20-22, 31-33, and 35-36 distinguish over the cited references. Therefore, the rejection of these claims under 35

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U.S.C. §103(a) should also be withdrawn.

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Conclusion

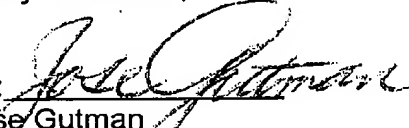
If for any reason the Examiner finds the application other than in condition for allowance, or the Examiner believes that there are any informalities which can be corrected by Examiner's amendment, a telephone call to the undersigned at (561) 989-9811 is respectfully solicited.

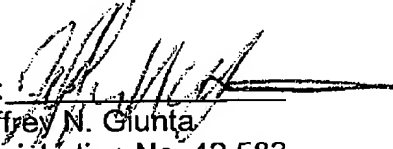
The Commissioner is hereby authorized to charge any fees that may be required or credit any overpayment to Deposit Account 09-0441.

In view of the foregoing, it is respectfully submitted that all of the grounds for rejection stated in the Examiner's office action have been overcome, and that the application and claims are in condition for allowance. Reexamination and reconsideration of the application, as amended, is requested.

Respectfully submitted,

Date: 11/3/, 2003

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